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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,489	11/30/2001	Matt Hayek	CS11336	6375
20280	7590	05/26/2006	EXAMINER	
MOTOROLA INC 600 NORTH US HIGHWAY 45 ROOM AS437 LIBERTYVILLE, IL 60048-5343			DANIEL JR, WILLIE J	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



MOTOROLA INC  
600 NORTH US HIGHWAY 45  
ROOM AS437  
LIBERTYVILLE IL 60048-5343

In re Application of:  
HAYEK, et al.  
Application Serial No.: 09/998,489  
Filed: November 30, 2001  
For: RF RECEIVERS AND METHODS

DECISION  
ON PETITION

This is a decision on the petition under 37 CFR 1.181 filed February 2, 2006 for supervisory review of the instant application. Petitioner argues that the response filed February 7, 2005 should be entered and prosecution be re-opened.

**PERTINENT BACKGROUND INFORMATION**

On September 25, 2003, a non-final Office action was mailed rejecting claims 11 and 13-25 under 35 USC 103.

On December 23, 2003, a timely response was filed by applicant arguing that the rejections were improper. Applicant specifically argued, for example, that the rejection of claims 11, 13-14, 18 and 24 under 35 USC 103 as being unpatentable over Atkinson was improper inasmuch as Atkinson failed to specifically disclose or teach specific limitations related to "... a voltage controlled oscillator having a frequency outside a bandwidth of received signal harmonics" as recited in claim 11.

On May 18, 2004 a Final Office action was mailed repeating the rejection of claims 11 and 13-25 under 35 USC 103.

On June 24, 2004, applicant filed an After Final response again arguing that the prior art of record failed disclose or teach specific claim limitations.

On August 18, 2004, a Notice of Appeal and Appeal Brief were timely filed.

On September 7, 2004, the examiner mailed an Advisory Action stating that the request for reconsideration has been considered but is not persuasive.

On January 10, 2005, an Examiner's Answer was mailed. The Examiner's Answer cited a new piece of prior art, "Mouly, et al., 'The GSM System for Mobile Communications', Cell & Sys., 1992, pp. 217-218." Furthermore, under "Grounds of Rejection", the examiner provided a note

in the Examiner's Answer which states "In response to Appellant's challenge to the Official Notice rejection of claims 11 and 22, the added reference of Mouly is provided as evidence to support the rejection." The Examiner's Answer then provided a new grounds of rejection wherein claims 11, 23-14, 18 and 24 are rejected under 35 USC 103 as being unpatentable over Atkinson in view of the newly cited reference Mouly, et al.

On February 7, 2005, Appellant filed a response under 37 CFR 1.111 wherein the response included an amendment to claims 11, 13, 14, 16, and 22; cancelled claims 15 and 23; and added new claims 26 and 27. Furthermore, the response included a request to re-open prosecution under 37 CFR 41.39 in light of the new grounds of rejection.

On July 7, 2005, the application was remanded from the Board of Appeals and Interferences for consideration of the response filed February 7, 2005.

On January 13, 2006, an Advisory Action After the Filing of an Appeal Brief was mailed, stating that the amendment filed February 7, 2005 will not be entered because it is not limited to canceling claims or rewriting dependent claims into independent form.

On February 2, 2006, petitioner filed the instant petition under 37 CFR 1.181. Petitioner argues that the response filed February 7, 2005 should be entered and prosecution re-opened inasmuch as examiner issued a new grounds of rejection by citing new reference (Mouly) in the Examiner's Answer mailed January 10, 2005.

## DECISION

MPEP 1207.03, part I, sets forth requirements for setting forth a new grounds of rejection in an Examiner's Answer as follows:

Any new ground of rejection made by an examiner in an answer must be:

- (A) approved by a Technology Center (TC) Director or designee; and
- (B) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer (see MPEP § 1207.02). The examiner may use form paragraph 12.154.04.

The examiner's answer must provide appellant a two-month time period for reply.

The examiner may use form paragraph 12.179.01 to notify appellant of the period for reply and to include the approval of the TC Director or designee. In response to an examiner's answer that contains a new ground of rejection, appellant must either file:

- (A) a reply in compliance with 37 CFR 1.111 to request that prosecution be reopened; or
- (B) a reply brief that addresses each new ground of rejection in compliance with 37 CFR 41.37(c)(1)(vii) to maintain the appeal.

A review of the file finds that the examiner failed to obtain approval of the Technology Center Director to make the new grounds of rejection in the Examiner's Answer. Furthermore, the appellant did file a timely reply in compliance with 37 CFR 1.111 and did request that prosecution be re-opened.

Inasmuch as it has been determined that the new grounds of rejection in the Examiner's Answer were improper, petitioner's request to have the February 7, 2005 response entered and for prosecution to be re-opened, is **Granted**.

The application file is being forwarded to the examiner for consideration of the February 7, 2005 amendment and reply, and for new and appropriate action in due course.



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Andrew Faile  
Director  
Technology Center 2600  
Communications